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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/643,765	08/23/2000	Teruyuki Motohashi	Q60573	9997

7590 07/20/2004  
Sughrue Mion Zinn MacPeak & Seas  
2100 Pennsylvania Avenue NW  
Washington, DC 20037-3202

EXAMINER

PEREZ GUTIERREZ, RAFAEL

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 07/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

14

# Office Action Summary

Application No.

09/643,765

Applicant(s)

Motohashi

Examiner

Rafael Perez-Gutierrez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,7-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,7-15 and 17-20 is/are rejected.
- 7) ☒ Claim(s) 2 and 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. This Action is in response to Applicant's after final amendment filed on October 30, 2003 and the telephone interview of January 28, 2004 between the Examiner and Ms. Melissa Patrick. **Claims 1, 2, 4, 5, 7-15, and 17-20** are now pending in the present application. **This Action is made NON-FINAL.**

### ***Response to Amendment***

2. The indicated allowability of **claims 3, 6, 9, 17, and 18** is withdrawn in view of the newly discovered reference to **Motohashi (U.S. Patent # 6,483,622 B1)**. Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless -- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claim 20** is rejected under 35 U.S.C. 102(e) as being anticipated by **Liukkonen et al. (U.S. Patent # 6,230,214 B1)**.

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Consider **claim 20**, Liukkonen et al. clearly show and disclose a mobile telephone 1 (portable radio terminal) (figure 1) with an infrared (IR) communication function 3 comprising:

a radio communication function section (not shown but inherent since it is a mobile telephone);

an infrared (IR) communication function section 3 (figure 1); and

a central processing unit (CPU) (information processing section) operable to inherently detect a function state of said radio communication function section (all mobile communication devices have a capability to judge or detect if the device is engaged in radio communications, otherwise, the device would not have the ability to activate certain features of the phone that are only operational when the device is engaged in radio communications. When the user detects an incoming call and decides to activate the phone to answer the call, the CPU of the phone must be able to detect the users actions to activate the radio communication portion of the phone, otherwise the user would be unable to answer or hang-up the phone. The CPU then judges or detects the function state of the radio section. See column 3 lines 31-60) and to control an IR output of said IR communication function section (column 3 lines 30-45), wherein said CPU (information processing section) controls the IR output from said IR communication function section such that said IR section outputs IR light (column 3 lines 30-45).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

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obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. **Claims 1, 4, 7-15, and 17-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Liukkonen et al. (U.S. Patent # 6,230,214 B1)** in view of **Motohashi (U.S. Patent # 6,483,622 B1)**.

Consider **claims 1, 4, 7-15, and 17-19**, Liukkonen et al. clearly show and disclose a communication method and a mobile telephone 1 (portable radio terminal) (figure 1) with an infrared (IR) communication function 3 including a central processing unit (CPU) (information processing section) operable to control an IR output of from said IR communication function section (column 3 lines 30-45), said mobile telephone and respective communication method comprising:

inherently judging/detecting, by said CPU (information processing section), whether or not the radio communications function is in radio communication (i.e., detecting the function

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state of the radio communication function section) (all mobile communication devices have a capability to judge or detect if the device is engaged in radio communications, otherwise, the device would not have the ability to activate certain features of the phone that are only operational when the device is engaged in radio communications. When the user detects an incoming call and decides to activate the phone to answer the call, the CPU of the phone must be able to detect the users actions to activate the radio communication portion of the phone, otherwise the user would be unable to answer or hang-up the phone. The CPU then judges or detects whether the device is in radio communications or not. See column 3 lines 31-60).

Nonetheless, Liukkonen et al. do not specifically disclose controlling a driving current of a light emitting element in the IR communication function section (claim 1), selecting an IR communication function section among a plurality of IR communication sections (claim 4), wherein a user is notified that a communicable distance of said IR communication function is restricted when the radio communication function section is in radio communication (claims 1 and 4), or wherein the IR output from said IR communication function section is not restricted when the CPU (information processing section) detects that there is no radio output (claim 7)

In the same field of endeavor, Motohashi clearly shows and discloses a communication method and a mobile data terminal comprising an IR communication function 2 (figures 1 and 2) in which a driving current of a light emitting element 21 (figure 2) in said IR function 2 is controlled thereby enabling light emitting element 21 to output IR light (abstract, column 1 lines 38-67, and column 2 line 37 - column 3 line 18), or comprising a plurality of IR communication function 20, 30 (figure 5) of which one is selected (column 2 lines 1-12 and column 4 lines 38-

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53), wherein a user is notified that a communicable distance of said IR function 21 is restricted depending on the remaining battery capacity (abstract, figure 3 step 306, figure 6 step 606, column 2 lines 55-64, and column 3 lines 51-57).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the current control technique of Motohashi into the method and telephone of Liukkonen et al. for the purpose of extending the battery life (Motohashi et al.; column 5 lines 21-33)

#### ***Allowable Subject Matter***

6. **Claims 2 and 5** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

7. Applicant's arguments with respect to **claims 19 and 20** have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

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8. Any response to this Office Action should be **faxed to (703) 872-9306 or mailed to:**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Hand-delivered responses** should be brought to

Crystal Park II  
2021 Crystal Drive  
Arlington, VA 22202  
Sixth Floor (Receptionist)

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rafael Perez-Gutierrez whose telephone number is (703) 308-8996. The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding



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should be directed to the receptionist whose telephone number is (703) 305-4700 or call customer service at (703) 306-0377.



Rafael Perez-Gutierrez  
R.P.G./rpg **RAFAEL PEREZ-GUTIERREZ**  
**PATENT EXAMINER**

July 12, 2004